

U.S. Patent Application No.: 10/552,628

**REMARKS**

The Office Action dated February 3, 2009 has been received and carefully considered. We have also carefully followed the advice received during a telephonic Interview on June 25, 2009 to update the Claims to better reflect the "method" nature of our filing.

In this response, Claims 1-8 have been cancelled and Claims 9-15 replaced with Claims 16-38.

The updated claims do not change the original scope of the invention – they just explicitly depict the environment by itemizing the elements involved in the method in question, along with the relationships between them, and the steps involved in the method – as requested by the Examiner during the telephonic interview. The method steps (Fig 2) and the environment diagrams (Fig 1) have also been provided for added clarity. No new matter has been added.

Entry of the Claims 16-38 is respectfully requested.

Reconsideration of the current rejection in the present application is also respectfully requested.

Although Claims 16-38 replace Claims 9-15 for clarity and specificity reasons, we are providing for continuity with the Office Action dated February 3, 2009 the following remarks. The remarks refer to the original claims and address the issue of conflict with Robinson et al.

U.S. Patent Application No.: 10/552,628

**I. THE ANTICIPATION REJECTION OF CLAIMS 9-12 AND 14-15**

On page 3-5 of the Office Action, Claims 9-12 and 14-15 were rejected under 35 U.S.C § 102 (e) as being anticipated by Robinson.

The Examiner asserts that Robinson discloses the claimed invention. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has replaced Claims 9-15 with Claims 16-38 to more specifically define the claimed invention, and specifically those features that differentiate the claimed invention from Robinson et al.. In particular, Applicant respectfully submits that Robinson et al, fail to disclose, or even suggest, that the method involves a system of ordering goods and services which is continuously monitoring the content being transmitted and thus is constantly aware of what is being transmitted at any moment in time; and that the system of ordering of goods and services is available for the duration of the content of the transmission; and that the offer of goods and services is made available to consumer by the consumer making a connection to the system of ordering of goods and services during the reception of the content being transmitted.

The method described in Robinson specifically assumes and consequently only applies to the circumstances in which the information about the object/element is encoded inside (in-band) of the transmission channel. The claimed invention makes no such assumption nor does it have such a requirement.

*[0043] Referring now to FIG. 1, there is shown one example embodiment of the system and apparatus of the invention. Raw motion picture programming 12 is obtained by a "shooting" process that uses analog or digital filming technology, such as a video camera or an emulsion film camera, or a digital camera. The raw*

U.S. Patent Application No.: 10/552,628

*programming 12 is edited and processed using editing equipment 14, wherein elements 16 in a scene 18 are identified during the editing process, or after final editing. In this example embodiment, "product" information 20 about each element, such as identification information for the element and/or where it can be purchased on the Internet is then encoded in digital form as part of a digital representation 21 of the programming material.*

Robinson explicitly states that the information about the product is encoded in the video stream. At the time when the video material is being exposed to the viewer on the TV monitor (while being broadcast or replayed from a recording) the viewer can explicitly identify the object/element of interest based on the information encoded in the video stream (e.g. by highlighting it). The viewer can also record/mark a specific frame so that the information stored in such frame could be used at later time for product ordering.

*[0044] Such digital programming material is then broadcast using a broadcast system 22, including a head end 24 that transmits the digital programming material by cable system 26 or satellite system 28, to a viewer's location 29, such as their home. At the viewer's location, a set top box 30, either stand alone or incorporated into television system, receives the digital programming material, typically carried over the air or cable in the form of a modulated analog carrier. The set top box 30 receives the programming, and produces a signal or data that produces a display 31 of the programming material on a television display 32. Set top box 30 is in one embodiment connected to the Internet by a POTS telephone line 33, or other Internet connection such as ISDN or DSL, and includes circuitry responsive to a hand held remote unit 34, which can be used to direct the set top box to overlay an image of a pointer 36 on a scene 38 of the*

U.S. Patent Application No.: 10/552,628

*programming material, and allowing a viewer to point to and electronically select an element in a scene. Remote unit 34 further includes, in one example embodiment, a keypad, a "purchase" button, and a toggle button to allow a viewer to toggle between different sets of customer information (not shown). According to one example embodiment, an indication that the element has been selected, and indeed is available to be selected, is also overlaid on the image of the scene, such as by changing a color or brightness of the element, or otherwise indicating visually that the element has been selected by the user. In one example embodiment, the hand held device allows a viewer to first freeze frame, or capture, an image of the scene, so that selection of the element is done a still video image, as opposed to a moving image. Moreover, the still video image may be stored for later recall, for example at the end of a broadcast, or at least an index to a point in the broadcast is made such that the user may later view an image from the scene obtained from a source other than the original broadcast, such as a recording of the broadcast made locally at the viewer's location, or a recording kept on a web server on the Internet or in some other remote database.*

U.S. Patent Application No.: 10/552,628

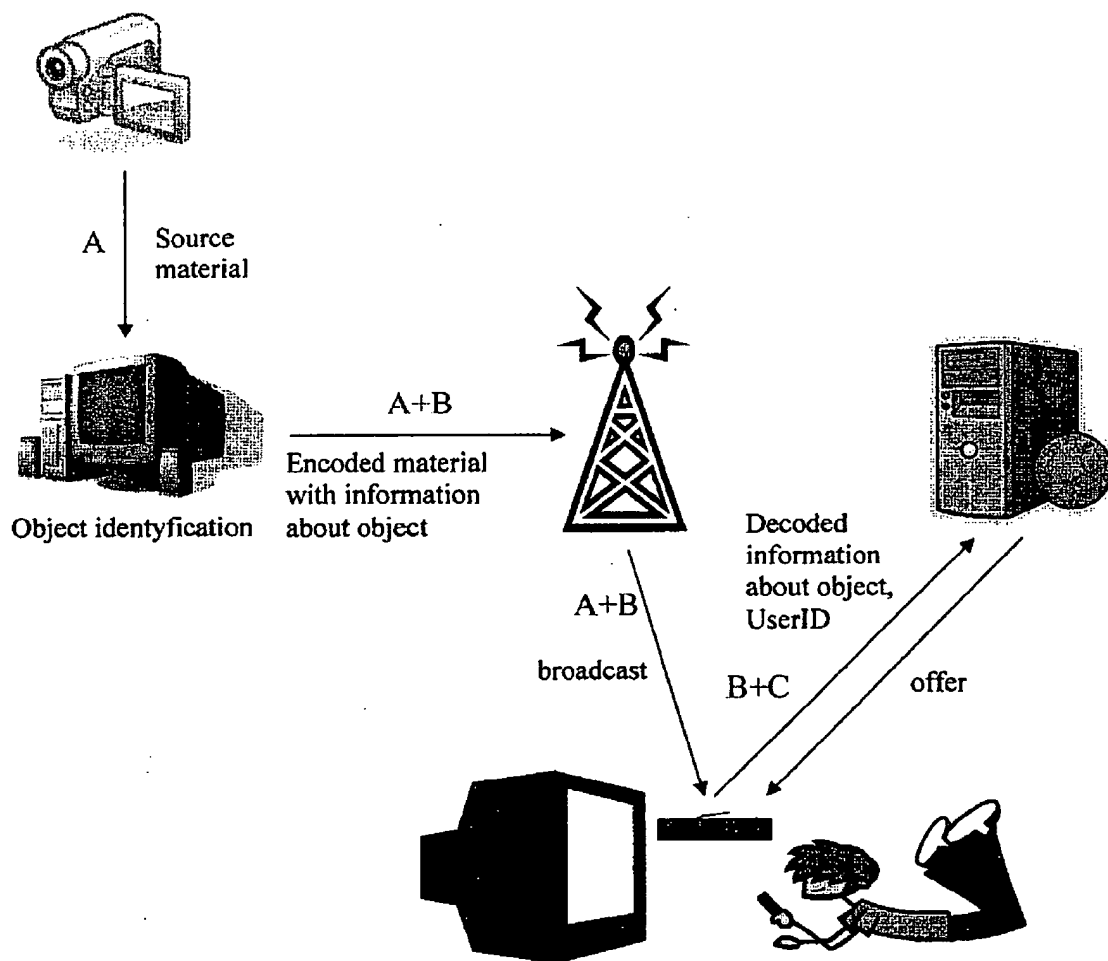


Fig.1

U.S. Patent Application No.: 10/552,628

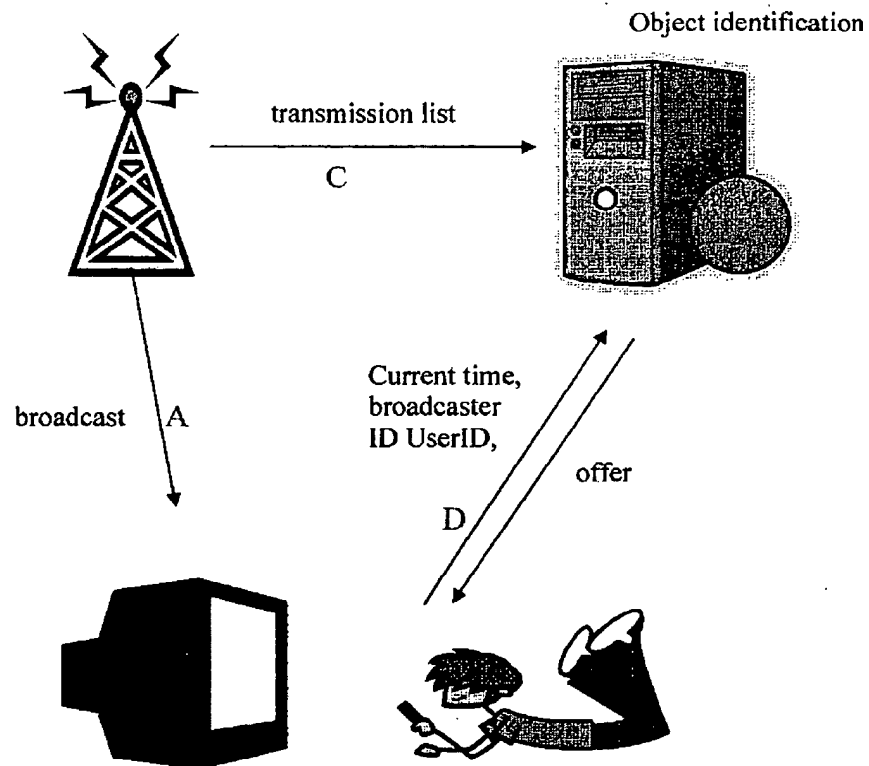


Fig.2

Fig 1 depicts the basic flow of the Robinson et al. method. Before the content is delivered to the viewer, it is merged with markers that identify the objects/elements of viewer's interest.

Fig 2 depicts the flow of the claimed invention which engages the out-of-band return channel and uses absolute time markers to identify the object/element of interest. The identification takes place on the server-side. Thus the method in claimed invention is fundamentally different from Robinson's.

Robinson writes:

U.S. Patent Application No.: 10/552,628

*[0009] As described below in greater detail, the invention exploits, in various embodiments described below, the concept of using, in particular but without limitation, traditionally non-commercial programming as a medium for selling products or services on-line, and again in particular over the Internet. Using this concept, for example, items used for props or settings of a scene in motion picture programming are made electronically identifiable by a viewer of the programming, and thereby enabling a viewer to determine the source or location of the goods or setting or other thing for sale, using an electronic system deployed in part as a portion of the viewer's television viewing equipment.*

Robinson explicitly points out that the objects/elements of interest are electronically identifiable in the content at the time of the transmission. The entire process of information flow and processing depends on the fact that the video content is merged with electronic markers before the content is broadcast (in step 2). Those markers are read and interpreted by the viewer (step 5) with the use of a purpose built decoder (which consequently sends them to the server). The presence of markers and the need for a decoder are both critical and pivotal in the Robinson invention.

*[0012] According to one embodiment of the invention, there is provided a method for selling products or services using a television-viewing medium. The method provides for 1) producing motion picture programming with at least one element in at least one scene of the motion picture programming, 2) recording digital information about the element, 3) broadcasting the motion picture programming, 4) receiving the broadcast and displaying the motion picture programming on a television display, 5) in response to viewing the motion*

U.S. Patent Application No.: 10/552,628

*picture programming on the television display, a viewer electronically selecting the element shown in the at least one scene, and 5) using the recorded digital information, linking the viewer to a web site configured to permit purchase or ordering of the element on-line.*

Robinson clearly stipulates that the information sent to the server contains product identifying data. The claimed invention states that what the consumer sends to the server is information about the current absolute time (not time relative to the beginning of the transmission) and the identifier of the broadcaster that emits the received content. In the claimed invention the specific and unique identification of the product is achieved by resolving the time mark against the transmission list obtained from the broadcaster. In the case of the Robinson invention the product identification (and marking) takes place in the post-production phase of the broadcast process. When Robinson allows for the omission of the product markers in-band of the transmission channel, the product is identified through the relative time (frame number) and the spatial coordinates (i.e. detail physical location of the object on the frame).

*[0019] In still another example embodiment of the methods of the invention, the viewer selects a position on the motion picture programming as it is displayed on the television display, and information about the position of the element and the time the element was selected is used to determine the identity of the element using the information stored concerning the location of the element in a scene of the motion picture programming.*



U.S. Patent Application No.: 10/552,628

Paragraph 19 confirms our position that regardless of similar final results which among other things could be a product order, the methods involved are substantially different – especially regarding **how** (based on what data and using what tools) and **where** the actual product is uniquely identified.

Futhermore, Robinson allows that the viewer may delay the ordering step until a later time. To make this possible a picture frame is reordered that contains the identification of the object/element of interest based on which a purchase can be made at a later time. The viewer is expected to recall and view such recorded frame for the purpose of specific object selection:

*[0022] In yet another example embodiment, the method provides for receiving the broadcast at a set top device and in response to a viewer's input freezes framing an image currently being displayed prior to the viewer selecting an element. The freeze-framed image is retrieved for later display and use to select an element.*

In the case of the claimed invention, only an absolute time marker is recorded, not the content itself or the object in that content. The time marker along with the broadcaster id are sufficient for object identification purposes.

The transmission of order parameters during the connection is not in and of itself innovative either for Robinson or for claimed invention. What is innovative in the claimed invention is the product identification process in which only certain parameters are transmitted to the server and used to determine the product identity. The said process in its entirety is substantially different from the

U.S. Patent Application No.: 10/552,628

Robinson process, with one of the differences being the content of the order parameters transmission.

*[0029] According to still another embodiment of the invention, one or more web servers or computing systems are used to collect viewing and purchasing data for viewers purchasing goods or services using the above described method. In one example embodiment, each viewer using the system is registered electronically at a web server system, and each time that viewer selects an element for investigation of a purchase, or actual purchase, the identity of that viewer, or at least some demographically information concerning the viewer such as their geographical location or age or gender, an identification of the motion picture programming from which the element is selected, and any actual sales information, is recorded on the server system for later reference, for example to "mine" information about viewing habits or purchasing habits of registered viewers.*

Robinson teaches that the data applicable/useful to processing of the potential sales transaction is collected and stored on the server for future use.

*[0029] According to still another embodiment of the invention, one or more web servers or computing systems are used to collect viewing and purchasing data for viewers purchasing goods or services using the above described method. In one example embodiment, each viewer using the system is registered electronically at a web server system, and each time that viewer selects an element for investigation of a purchase, or actual purchase, the identity of that viewer, or at least some demographically information concerning the viewer such*

U.S. Patent Application No.: 10/552,628

*as their geographical location or age or gender, an identification of the motion picture programming from which the element is selected, and any actual sales information, is recorded on the server system for later reference, for example to "mine" information about viewing habits or purchasing habits of registered viewers.*

In the case of the claimed invention the data are not so much stored (in a ready form for use) on the server but they are first acquired/derived from various sources (servers) based on the viewer and broadcaster identification data and the time marker. The claimed invention describes a server-side based method in which the input is collected without significant interference with the traditional content delivery methods and processes or the required alteration of viewer behavior. The input data is consequently used to obtain what the viewer is interested in and inform his decision on purchase.

Robinson teaches that the information regarding the purchase order is stored on the server for the purpose of future use:

*[0029] According to still another embodiment of the invention, one or more web servers or computing systems are used to collect viewing and purchasing data for viewers purchasing goods or services using the above described method. In one example embodiment, each viewer using the system is registered electronically at a web server system, and each time that viewer selects an element for investigation of a purchase, or actual purchase, the identity of that viewer, or at least some demographically information concerning the viewer such as their geographical location or age or gender, an identification of the motion picture programming from which the element is selected, and any actual sales*

U.S. Patent Application No.: 10/552,628

information, is recorded on the server system for later reference, for example to "mine" information about viewing habits or purchasing habits of registered viewers.

The claimed invention states that what is transmitted to the server-side is a notification (a tag) that indicates that at a certain moment in time, the viewer was interested in certain content emitted/exposed to the viewer by a certain content provider. The time marker is stored on the server-side (as opposed to the viewer-side as is the case with Robinson). At the time of marking, the viewer did not receive an offer and no information on the object is gathered on the viewer side to be sent to the server. The claimed invention posits that the required input data is limited to: viewer id, broadcaster id, and the time marker.

As it has been depicted in all Robinson claims, Robinson refers and applies to TV transmission. The claimed invention posits to apply to other content delivery media including but not limited to radio, Internet, billboards, print, etc.

U.S. Patent Application No.: 10/552,628

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**JUL 06 2009****II. CONCLUSION**

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact me or Mr. Mirek Kula, the applicant's technical adviser, by email: mirek.kula@gmail.com or telephone +1 401 935-3296 or fax +1 401 349-2412, in order to expedite resolution of any issues.

Respectfully submitted,

  
Henryk Kulakowski  
Applicant